

Paper 1

Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-4683
Fax: 571-273-0042

Filed: 15 December 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

EDWARD L. TOBINICK
Junior Party
(Patents 6,419,944 and 6,537,549),

v.

JUNMING LE, JAN VILCEK, PETER DADDONA,
JOHN GHRAYEB, DAVID KNIGHT,
and SCOTT SIEGEL,
Senior Party
(Application Nos. 10/227,488 and 10/665,971).

**Patent Interference No. 105,841
(Technology Center 1600)**

DECLARATION - Bd.R. 203(b)¹

Part A. Declaration of interference

4 An interference is declared (35 U.S.C. § 135(a)) between the above-identified
5 parties. Details of the application(s), patent (if any), reissue application (if any), count(s)

¹ "Bd.R. x" may be used as shorthand for "37 C.F.R. ' 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1 and claims designated as corresponding or as not corresponding to the count(s) appear
2 in Parts E and F of this DECLARATION.

3 **Part B. Judge managing the interference**

4 Administrative Patent Judge Sally Gardner Lane has been designated to manage
5 the interference. Bd. R. 104(a).

6 **Part C. Standing order**

7 A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this
8 DECLARATION. The STANDING ORDER applies to this interference.

9 **Part D. Initial conference call**

10 A telephone conference call to discuss the interference is set for **2:00 p.m. on 1**
11 **March 2012** (the Board will initiate the call).

12 No later than **four business days** prior to the conference call, each party shall
13 file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd. R. 120; Bd. R. 204;
14 SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

15 A sample schedule for taking action during the motion phase appears as Form 2
16 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to
17 the conference call and to agree on dates for taking action. A typical motion period
18 lasts approximately eight (8) months. Counsel should be prepared to justify any request
19 for a shorter or longer period.

20

1 **Part E. Identification and order of the parties**

2 Junior Party

3 Named Inventors: EDWARD L. TOBINICK
4 Los Angeles, CA
5

6 Involved Patents: 6,419,944, issued 16 July 2002, from application
7 09/826,976, filed 05 April 2001

8 CYTOKINE ANTAGONISTS FOR THE TREATMENT OF
9 LOCALIZED DISORDERS
10

11 6,537,549, issued 25 March 2003, from application
12 09/841,844, filed 25 April 2001

13 CYTOKINE ANTAGONISTS FOR THE TREATMENT OF
14 LOCALIZED DISORDERS
15
16

17 Assignee: Tact IP, LLC
18

19 Senior Party

20 Named inventors: JUNMING LE
21 Jackson Heights, NY
22

23 JAN VILCECK
24 New York, NY
25

26 PETER DADDONA
27 Menlo Park, CA
28

29 JOHN GHRAYEB
30 Downington, PA
31

32 DAVID KNIGHT
33 Berwyn, PA
34

35 SCOTT SIEGEL
36 Westborough, MA
37

1 Involved Applications: 10/227,488, filed 23 August 2002
2
3 METHODS OF TREATING INFLAMMATION ASSOCIATED
4 WITH NEURODEGENERATIVE DISEASES WITH ANTI-
5 TNF α ANTIBODIES
6

7 10/665,971, filed 19 September 2003.

8 METHODS OF TREATING NEURODEGENERATIVE
9 INFLAMMATION WITH ANTI-TNF ALPHA ANTIBODIES
10
11

12 Assignee: Janssen Biotech, Inc.
13

14 The senior party is assigned exhibit numbers 1001-1999. The junior party is
15 assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1); SO ¶ 154.2.1. The senior party
16 is responsible for initiating settlement discussions. SO ¶ 126.1.

17 **Part F. Count and claims of the parties**

18 Count 1

19 Claim 1 of Tobinick US Patent 6,419,944

20 or

21 Claim 1 of Tobinick US Patent 6,537,549

22 or

23 Claim 4 of Le 10/227,488

24 or

25 Claim 1 of Le application 10/665,971

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1 The claims of the parties are:

2 Tobinick ('944): 1-38

3 Tobinick ('549): 1-33

4 Le ('488): 4, 7-10, 32, 33, 37, 53-58, 60-65, 85, 87, and 88

5

6

7 Le ('971): 1-7, 18-20, and 22-37

8

9

10 The claims of the parties which correspond to Count 1 are:

11 Tobinick ('944): 1-38

12 Tobinick ('549): 1-33

13

14 Le ('488): 4, 7-10, 32, 33, 37, 53-58, 60-65, 85, 87, and 88

15

16 Le ('971): 1-7, 18-20, and 22-37

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19

20 The claims of the parties which do not correspond to Count 1, and therefore are

21 not involved in the interference, are:

22 Tobinick ('944): None

23 Tobinick ('549): None

24

25 Le ('488): None

26

27 Le ('971): None

28

29

30 The parties are accorded the following benefit for Count 1:

31 Tobinick: 09/563,651, filed 02 May 2000, issued as US Patent
32 6,471,961;

33

34 09/476,643, filed 31 December 1999, issued as
35 6,177,077;

36

09/275,070, filed 23 March 1999, issued as
6,015,557; and

09/256,388, filed 24 February 1999, abandoned.

Le:
09/133,119², filed 12 August 1998, issued as US Patent 6,277,969;
08/570,674, filed 11 December 1995, abandoned;
08/324,799, filed 18 October 1994, issued as US Patent 5,698,195;
08/192,102, filed 04 February 1994, issued as US Patent 5,656,272;
08/192,861, filed 04 February 1994, issued as US Patent 5,919,452;
08/192,093, filed 04 February 1994, issued as US Patent 6,284,471;
08/010,406, filed 29 January 1993, abandoned;
08/013,413, filed 02 February 1993, abandoned;
07/943,852, filed 11 September 1992, abandoned;
07/853,606, filed 18 March 1992, abandoned;
07/670,827, filed 18 March 1991, now abandoned.

² The involved Le application no. 10/227,488 is a continuation of application no. 09/766,535, filed 18 January 2001, which issued as US Patent 6,991,791 and is a divisional of application no. 09/133,119. The involved Le application no. 10/665,971 is a divisional of application no. 09/756,398, which issued as US patent 6,835,823 and is a divisional of application no. 09/133,119.

1 **Part G. Heading to be used on papers**

2 The following heading must be used on all papers filed in this interference, see

3 SO ¶ 106.1.1:

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Patent Interference No. 105,841
(Technology Center 1600)

Part H. Order form for requesting file copies

1 When requesting copies of files, use of SO Form 4 will greatly expedite
2 processing of the request. Please attach a copy of Parts E and F of this
3 DECLARATION with a hand-drawn circle around the patents and applications for which
4 a copy of a file wrapper is requested.

/Sally Gardner Lane/
Administrative Patent Judge

Enc:

Copy of STANDING ORDER
Copy U.S. Patent 6,537,549
Copy U.S. Patent 6,419,944
Copy of claims of 10/655,971
Copy of claims of 10/227,488

cc (via overnight delivery):

Attorney for Tobinick:

Ezra Sutton, PA
Plaza 9, 900 Route 9
Woodbridge, NJ 07095

Neifeld IP Law, PC
4813-B Eisenhower Avenue
Alexandria, VA 22304

Attorney for Le:

Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
Concord, MA 01742-9133